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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.          | CONFIRMATION NO.       |
|---|-------------|----------------------|------------------------------|------------------------|
| 10/633,113  | 08/01/2003  | Michael Beuten       | 10191/3300                   | 3639                   |
| 26646   | 7590        | 04/20/2007           |                              |                        |
| KENYON & KENYON LLP<br>ONE BROADWAY<br>NEW YORK, NY 10004 |             |                      | EXAMINER<br>CHERY, MARDOCHEE |                        |
|   |             |                      | ART UNIT<br>2188             | PAPER NUMBER           |
|   |             |                      | MAIL DATE<br>04/20/2007      | DELIVERY MODE<br>PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/633,113

Applicant(s)

BEUTEN ET AL.

Examiner

Mardochee Chery

Art Unit

2188

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 27 March 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: \_\_\_\_\_.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

  
HYUNG SOUGH  
SUPERVISORY PATENT EXAMINER  
4-18-07

Continuation of 11. does NOT place the application in condition for allowance because: 1. Applicants contend on page 5, paragraph 1 of the remarks that "Sorber explicitly indicates that the startup program is contained in the program memory 20 which is separate from the data memory 22" and cites col. 7, ll 1-14 in support of these allegations.

However, Examiner has carefully reviewed column 7, lines 1-14, and the entire disclosure of Sorber and finds no teaching whatsoever, whether implicitly or explicitly, of "the startup program being contained in the program memory 20 which is separate from the data memory 22" as alleged by applicants.

2. Applicants further purport on page 5, paragraph 1, that "the statement of col. 16, ll 54-57 of Sorber provides no context regarding which specific memory blocks are being referenced. In any case, each available memory block clearly cannot refer to the memory block containing the startup program".

Examiner respectfully disagrees with such contention. First of all Examiner would like to make it clear that column 16, lines 54-57 of Sorber was relied upon for teaching the simply claimed limitation of "connecting the first memory block and the additional memory blocks by a chained list" and Sorber in column 16, lines 54-57 clearly teaches [each available memory block is linked to a next, available memory block and a first memory block is indicated by a pointer]. Thus, Sorber clearly teaches at least "connecting a first memory block and additional memory blocks by a chained list which in turn is explicitly states which specific memory blocks are being referenced". Examiner would like to additionally emphasize that applicants' arguments appear as though the claim recites "a memory block referring to the memory block containing the startup program". However, such limitation is not recited in the claim.

3. Applicants still further argue on page 5, paragraph 1 of the remarks, that "column 16, lines 54-57 has absolutely nothing to do with linking of the memory block containing the startup program, and there is absolutely no teaching or suggestion in Sorber that the memory block containing the startup program (which is clearly in program memory 20) is connected to additional memory blocks by a chained list".

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., linking of the memory block containing the startup program and memory block containing the startup program connected to additional memory blocks by a chained list) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

4. Applicants argue on page 5, paragraph 2 to page 6, paragraph 1 of the remarks that "column 4, lines 3-13 of Porterfield has nothing to do with the startup program obtaining data for a check of the memory device, which data are obtained from the additional memory blocks".

Examiner strongly disagrees. Porterfield clearly discloses "a first portion of the system memory is allocated addresses 0 through 15 M, these addresses will be set by the Basic Input-Output System (BIOS) software when the computer system is initialized upon turned ON; col. 4, ll 3-13". By definition and in conventional practice, BIOS is the set of essential software routines that tests hardware at startup. Thus, the BIOS in the system of Porterfield obtains data from a first portion of memory which is then tested at startup.

5. Applicants argue on page 6, paragraph 2 of the remarks that "there is absolutely no suggestion in Bright regarding any memory device containing the startup program and the additional memory blocks is checked let alone that any such memory device is checked before any chained list is executed".

First of Examiner would like to make it clear that the combination of Sorber, Porterfield, and Bright is relied upon in rejecting the claims. Additionally, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Furthermore, Bright unequivocally discloses "the program stored in the external device has added authenticity information, such as a checksum, hash and so forth, which authenticity information must be authenticated by the processor before the program may be executed; col. 3, ll 15-27", where it is readily apparent that an executable program includes chained lists that upon execution of the program are also being executed.

6. Applicants further argue on page 6, paragraph 3 of the remarks that there is no logical reason why any person of ordinary skill in the art would be motivated to make the modifications asserted by the Examiner, particularly when one considers the completely different technologies involved in the applied references.

Examiner strongly disagrees. First of all, the modification to combine the references was clearly stated on pages 4-5 of the Office action mailed on November 2, 2006. Additionally, contrary to applicants' assumption, the references do not involve different technologies. Sorber deals with "allocation and management of memory"; Porterfield relates to "allocating address space to a system memory"; and Bright pertains to "reading a program from a memory into a processor". Thus, it is manifest that Sorber, Porterfield, and Bright do not involve different technologies. In view of the foregoing, it has been clearly shown that the claimed invention is not patentable over the combination of Sorber, Porterfield and Bright.